

**Remarks**

The application has been amended to place the application in condition for allowance at the time of the next Official Action.

Claims 26-38 and 44-47 are pending in the application. Claims 26-33, 38, 44 and 47 are withdrawn from further consideration as being drawn to a non-elected species.

Claims 34-37, 45 and 46 are rejected as unpatentable over Japanese Patent No. 9-268219 in view of Japanese Patent Nos. 57-38814 and 58-150581. This rejection is respectfully traversed.

Independent claim 34 is amended and provides that the ratio of a tetraphenylolthane epoxy resin to a phenolbiphenylaralkyl epoxy resin is no less than 1 to 5. Claim 34 further provides that the composition comprises no flame retardant material nor flame retardant auxiliary.

The position set forth in the Official Action is that JP '219 teaches a phenol-biphenyl aralkyl epoxy resin and that such epoxy resin can be combined with another epoxy resin. The Official Action offers JP '814 and JP '518 as teaching a tetraphenylolthane epoxy resin and concludes that it would be obvious to combine these tetraphenylolthane epoxy resins with the epoxy resin of JP '219 to render obvious the claims of the present application.

However, this conclusion is believed untenable for the following reasons.

First, neither JP '219 nor JP '814 nor JP '581 teach or suggest an epoxy resin composition that is flame retardant without comprising a flame retardant material nor a flame retardant auxiliary.

Rather, JP '814 and JP '581 teach a tetraphenylolthane epoxy resin having improved thermal properties such as heat distortion and mechanical properties.

JP '219 teaches an epoxy resin composition that will have good heat resistance, water resistance, toughness and mechanical strength.

Second, JP '219 only suggests the possibility of combining phenol-biphenyl aralkyl epoxy resin with another epoxy resin. However, paragraph 0003 of JP '219 provides "although thermal resistance increases in the cured product obtained when polyfunctional epoxy resins, such as a cresol novolak epoxy resin, are mixed, said product has such fault that toughness decreases and water absorption increases". Accordingly, JP '219 teaches that although such a combination of epoxy resins is possible, they are undesirable.

Moreover, as set forth above, an object of JP '219 is to have an epoxy resin composition that will have good water resistance and toughness. The tetraphenylolthane epoxy resin of

JP '814 and JP '581 is typical of polyfunctional epoxy resins. Accordingly, combining the tetraphenylolthane epoxy resin with the phenol-biphenyl aralkyl epoxy resin of JP '219 would result in poor water resistance and toughness. An epoxy resin composition thus formed would be unsatisfactory for the required good water resistance and toughness in JP '219.

The Federal Circuit has held that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Accordingly, not only would the proposed combination of references fail to teach an epoxy resin composition that exhibits flame retardants without any help of flame retardant material or flame retardant auxiliary, there is no motivation to combine the references in the first instance because such combination would render the prior art invention being modified unsatisfactory for its intended purpose.

Third, even if one of ordinary skill in the art were to combine the phenol-biphenyl aralkyl epoxy resin of JP '219 with a polyfunctional epoxy resin as suggested in JP '219 wherein the polyfunctional epoxy resin is a tetraphenylolthane epoxy resin as suggested in the Official Action, there is no teaching or

suggestion that the ratio of the tetraphenylolthane epoxy resin to the phenol-biphenyl aralkyl epoxy resin is no less than 1/5.

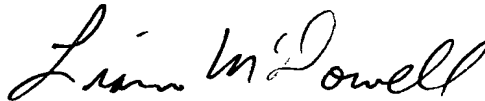
Thus, it is believed to be apparent from the above discussion, to the extent that the skilled artisan might have considered the proposed combination of references together in the first instance, the invention of the present claims would not have been suggested. Reconsideration and withdrawal of the rejection are respectfully requested.

Support for the subject matter of amended claim 34 can be found on page 47, Table 5, examples 18-20.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

YOUNG & THOMPSON



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Liam McDowell, Reg. No. 44,231  
745 South 23<sup>rd</sup> Street  
Arlington, VA 22202  
Telephone (703) 521-2297  
Telefax (703) 685-0573  
(703) 979-4709

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